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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,445	09/12/2003	Terry Karanikas	KARA-2798US2	7819
5409	7590	02/24/2005	EXAMINER	
ARLEN L. OLSEN SCHMEISER, OLSEN & WATTS 3 LEAR JET LANE SUITE 201 LATHAM, NY 12110			SAFAVI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3673	
DATE MAILED: 02/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/661,445

Applicant(s)

KARANIKAS, TERRY

Examiner

M. Safavi

Art Unit

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to describe the limitation or condition of. Such appears to be new matter. It is otherwise, not clear as to how the discrete components are not supported prior to the pour application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, line 9, it is not clear as to what is being defined by the recitation of "end surfaces simultaneously supports a plurality of layers of discrete components during, *but not prior to*, a single pour application of a binding material". The specification does not appear to clearly describe such a limitation or condition. It is otherwise, not clear as to how the discrete components are not supported prior to the pour application.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Dial, Jr. '424. Dial, Jr. teaches a method of constructing a wall unit using a molding technique comprising operationally attaching a plurality of panels in an upright manner and filling the volume with a binding material (Fig. 6 and col. 5, lines 22-28), and subsequent to curing of the binding material, removing the panels (col. 5, lines 5, lines 46-49). Dial also teaches arranging at least one layer of discrete veneer components 64 adjacent one of the plurality of panels 66 (Fig. 15-16 and col. 8, lines 8-32). The provision of the openings 62 in the interior face 60 of the mold panel 66 provides spacers which inherently comprises the step of placing shim material between the discrete veneer components. Dial also teaches forming an indentation 92 to prepare a seamless joint (Fig. 19 and col. 8, lines 33-37). Dial teaches adding a coloring agent to the binding material (col. 9, lines 12-15). Prior to the step of filling the volume with the

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binding material, Dial teaches providing for at least one chaseway 5 and adding reinforcing rods 3 into the form before the step of filling the volume (Fig. 8, and col. 4, lines 56-60). Dial teaches the step of removably attaching shaped structures, or discrete components, 16,16a to the panels 17 to form an indentation in a surface; Dial teaches aligning the shaped structures (e.g. col. 6, lines 38-40). Dial teaches a wall unit form (Fig. 6) comprising a first, second, and end surfaces 17,17a operatively attached thereby forming an upright form and opposing sides; pocket structures 16,16a are operatively attached to the surfaces.

Claims 15, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Carvel '504. Carvel teaches, Figs. 26-33, a wall unit form 31 comprising first, second, and end surfaces operatively attached forming an upright form and opposing sides. The surfaces are hingedly attached (page 3, lines 58-62). Pocket structures, or discreet components, 8 are operatively attached to surfaces.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over either of Dial, Jr. 424 or Carvel '504 in view of Schultz '761.

Neither Dial nor Carvel discloses forming a void/volume to produce an integral base/footing. Schultz (Figs. 2-5) shows forming a void/volume by providing extensions 9 on a mold to produce an integral base/footing; note that Schultz also teaches that the volume may have radiused corners as at 59 or 61. Accordingly, it would have been obvious to one with ordinary skill in the art to modify the mold of Dial or Carvel to include extensions forming a void/volume, optionally including radiused corners, as taught by Schultz in order to provide integral forming of a footing. Note that this modification is consistent with Dial's disclosure that architectural details may be built into the blocks (e.g. note block 93 in Fig. 14 and corresponding description in col. 7, lines 65-67) and Carvel's disclosure that the method may be employed to form wall sections of any desired shape such as may be designed by an architect for any particular part of the building (note page 3, lines 77-87).

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dial, Jr. '424 or Carvel '504 in view of Torricelli '570.

Dial only shows a rectangular wall unit and form. Carvel teaches a wall unit form based on rectangular aspects. Blocks having non-rectangular shapes, however, are notoriously old and well known in the art of building construction and wall units, the blocks formed as appropriate for the desired application and varied in shape to provide adaptability for constructions therewith. As merely an example, Torricelli teaches both a rectangular block (Figs. 1-4) and teaches a curved block (Fig. 12) to be a modification thereof. Accordingly, it would have been obvious and well within the skill of one with

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ordinary skill in the art to modify the wall unit form of Dial or Carvel to include a non-rectangular aspect or curved wall panel design(s) in order to enable creation of correspondingly shaped non-rectangular blocks since non-rectangular blocks were notoriously old and well known in the art, as exemplified by Torricelli.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-19 of U.S. Patent No. 6,629,395. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious, if not inherent, to one having ordinary skill in the art to have provided the claimed wall unit form of patent no. 6,629,395 with at least one of the surfaces supporting a plurality of the discrete components.

***Response to Arguments***

Applicant's arguments filed December 07, 2004 have been fully considered but they are not persuasive. Applicant appears to be arguing method with respect to "...end surfaces simultaneously supports a plurality of layers of discrete components during, *but not prior to*, a single pour application of a binding material". Such method limitation is not afforded weight in a claim to structure particularly with the applied prior art disclosing, alone or as modified, all the limitations of the rejected claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2481. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MICHAEL SAFAVI  
PRIMARY EXAMINER  
ART UNIT 354**

M. Safavi  
February 15, 2005